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JAMES H. McKENNEY,
Clerk

Supreme Court of the United States.

October Term, 1903.

No. 13. ORIGINAL.

Ex parte HERMAN FRASCH, Petitioner.

PETITION FOR WRIT OF MANDAMUS.

Motion for Writ, Notwithstanding Return, and for Other or Further Relief.

BRIEF FOR PETITIONER.

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Supreme Court of the United States.

October Term, 1903. No. 13, Original.

EX PARTE HERMAN FRASCH, PETITIONER.

Petition for Writ of Mandamus to Court of Appeals District of Columbia—Motion after Return.

And now, to wit, this 14th day of December, 1903, comes the above-named petitioner, by his attorney, and moves the court to issue a writ of mandamus as prayed for, notwithstanding the return of the justices of the Court of Appeals of the District of Columbia, and to grant such other or further relief as may be proper in the premises.

HERMAN FRASCH,

By Chas. J. Hedrick, his Attorney.

IN THE

Supreme Court of the United States.

October Term, 1903.

No. 13, ORIGINAL.

EX PARTE HERMAN FRASCH, PETITIONER.

PETITION FOR WRIT OF MANDAMUS.

BRIEF FOR PETITIONER.

The present brief is additional to arguments in the exhibits annexed to petition.

Statement of the Case.

An appeal taken from a decision of the Commissioner of Patents to the Court of Appeals, D. C., was dismissed for supposed want of jurisdiction in the court to hear and determine the same. A petition was filed for a writ of mandamus directing that the appeal be heard and determined.

A rule to show cause having issued and return having been made, the petitioner now asks for allowance of the writ, notwithstanding the return, and for such other or further relief as may be proper in the premises.

In the patent office are three tribunals:

(1) The Primary Examiner (sec. 482, R. S.),

(2) The Board of Examiners-in-chief (sec. 482, R. S.),

(3) The Commissioner (sec. 481, R. S.).

The last named claims, and, in fact, exercises, not only appellate, but also original authority over all applications in every stage, except as controlled by the courts (Anderson and Dyer *vs.* Lowry, 89 Official Gazette, 230); and this claim has received recognition by the Supreme Court, D. C. (Hull *vs.* Commissioner, 7 Official Gazette, 559, and 8 Official Gazette, 46), and by the Court of Appeals, D. C. (Drawbaugh *vs.* Commissioner of Patents, 77 Official Gazette, 313). This plenary authority is not beyond question (Butterworth *vs.* U. S. *ex rel* Hoe, 112 S., 50, 67; dissenting opinion in Hull *vs.* Commissioner, 7 Official Gazette, 562).

The Commissioner objects to petitioner's application for patent solely on the ground that the claims are drawn, some to a process and others to an apparatus.

To enforce such objection he has, by his decision sought to be reviewed,

(1) affirmed a final decision of the Primary Examiner requiring the cancellation of one set of claims;

(2) affirmed the Primary Examiner's decision refusing further action upon the application until one set of claims should be canceled;

(3) refused to allow the Examiners-in-chief to hear an appeal which petitioner took from the final decision of the Primary Examiner aforesaid;

(4) refused to make any order or action whereby fur-

ther proceedings could be had in the patent office (without waiver of claim) or to afford any relief whatever in the premises.

Petitioner has all along asserted, and no tribunal has denied, that the *description* of both process and apparatus is proper and, indeed, necessary (exhibit record, page 15). Under the Commissioner's decision the *claim* to one o them must be *canceled* while the *disclosure* of both must remain. There is no showing as to how, if at all, the process and apparatus could be used separately.

The reasons which petitioner assigned to the Commissioner for the former's appeal to the Court of Appeals (pages 1-7 of exhibit record) are printed in the Appendix hereto (pages i-viii *post*).

Points.

I. Petitioner's process and apparatus are both essential to a patentable invention under section 4886, R. S.

II. His process and apparatus are both necessarily embraced in the description required by section 4888, R. S.

III. He could not obtain two valid patents without showing a capacity for separate use on the part of his process and his apparatus, respectively, nor could he have two valid patents with the same essential disclosure in each.

IV. He is entitled to one patent with both sets of claims therein.

V. The Commissioner in person has definitely rejected petitioner's application as to part of the invention therein and has refused him the patent applied for.

VI. His decision is not interlocutory but final.

VII. Further proceedings in the patent office would be fruitless.

VIII. The Court of Appeals had and has jurisdiction to hear and determine petitioner's appeal.

IX. Mandamus to the Court of Appeals is petitioner's proper remedy.

X. Petitioner is entitled to some remedy by judicial process.

I.

The petitioner's process and apparatus are both essential to a patentable invention.

> "A patentable invention is a mental result. * * Everything within the domain of the conception belongs to him who conceived it." (Smith *vs.* Nichols, 21 Wallace, 112, 118.)

For obtaining salt from brine, it is common to heat the brine by steam pipes immersed therein; and, inasmuch as brine ordinarily contains calcium sulphate (otherwise sulphate of calcium, sulphate of lime, gypsum), these pipes become incrusted with a coat of calcium sulphate, which interferes with the transmission of heat from the steam to the brine, and which has to be removed from time to time.

Prior to petitioner's invention, the heating of the brine had to stop during each removal of the incrusting coat; and considerable expense for labor was involved in effecting the removals. With the aid of said invention neither stoppage of the heating operation nor additional labor is required.

I: Invention of both Process and Apparatus essential to Patentability.

Petitioner conceived that the calcium sulphate could be removed by the action of condensing steam and that the same steam which by its condensation is heating a batch of brine might be simultaneously employed in removing the calcium sulphate deposited from a previous batch.

But, to be patentable, petitioner's new conception had to be "shown to be of practical utility" by having "its material reflex and embodiment" (Smith *vs.* Nichols, as above) in a "machine, process or product" (*ibidem*).

> "A machine is a thing * * visible to the eye—an object of perpetual observation." (Tilghman *vs.* Proctor, 102 U. S., 707, 728.)
>
> "A process is an act or mode of acting * * seen only in its effects when being executed or performed" (*ibidem*).
>
> "When a mode of doing a thing is referred to as something permanent, it is properly termed an *engine*; when to something fugitive a *method*" (page 18 of appendix to 3 Wheaton).

Petitioner's new conceptions required a double embodiment; because the steam and the brine, whose actions are fugitive and seen only in the effects when petitioner's process is "being executed or performed," had to be confined and controlled by an appropriate apparatus which is *permanent* and *visible*.

In LeRoy *vs.* Tatham, the new conception was that seamless lead pipe could be made by dividing the lead and bringing the parts together under heat and pressure. The court said:

> "In regard to the practical application of the new conception, it is as necessary as the conception itself and they must unite in the patent" (22 Howard, 132. 139).

The Tathams' process demanded visible appliances to confine and control the lead; but the apparatus which they used was before known in the manufacture of macaroni.

Petitioner's case was different: no prior apparatus available by him had previously existed. He was obliged, therefore, to originate both a process and an apparatus in order to have an invention which, in the language of section 4886 R. S., should be useful as well as new.

> "The patent was supported because he (Neilson) had invented a mechanical apparatus by which a current of hot air, instead of cold, could be thrown in, and this new method was protected by the patent" (O'Reilly *vs.* Morse, 15 Howard, 62, 116).

> "he was entitled to a patent for that process * * having * pointed out a particular apparatus for that purpose, and having thus shown that the process could be practically and usefully applied" (Tilghman *vs.* Proctor, 102 U. S., 707, 724–725).

> "The art consists in so controlling the force as to make it accomplish its purpose. * * * Bell discovered that it could be done by gradually changing the intensity of a continuous electric current, so as to make it correspond exactly to the changes in the density of the air, caused by the sound of the voice. This was his art. He then devised a way in which these changes of intensity could be made and speech actually transmitted." (The Telephone Cases, 126 U. S., 1, 532-533.)

II.

Petitioner's process and apparatus are both necessarily embraced in the description required by section 4888, R. S

This section, referring to the "invention or discovery," requires

> "a written description of the same, and of the manner and process of making, constructing, compounding, and using it."

> "Perhaps the process is susceptible of being applied in many modes, and by the use of many forms of apparatus. The inventor is not bound to describe them all in order to secure to himself the exclusive right to the process, if he is really its inventor or discoverer. But he must describe some particular mode, or some apparatus by which the process can be applied with at least some beneficial result, in order to show that it is capable of being exhibited and performed in actual experience. (Tilghman *vs.* Proctor, 102 U. S., 707, 728-729.)

> "If the mode of doing it, or the apparatus in or by which it may be done is sufficiently obvious to suggest itself to a person skilled in the particular art, it is enough in the patent to point out the process to be performed without giving supererogatory directions as to the apparatus or method to be employed." (*Ibidem*, 728.)

This is only another way of saying that

> "That which is common and well known is as if it were written out in the patent and delineated in the drawings." (Webster Loom Co. *vs.* Higgins, 105 U. S., 580, 586.)

In such case any necessary apparatus would be embraced in the written description as effectually as if

"delineated in the drawings," and it is none the less true that such reflex and embodiment in visible and permanent form is, if new, as much "within the domain of the conception" (Smith *vs.* Nichols, 21 Wallace, 112, 118) as the process itself.

To avoid doubtful disputation, it is commonly safer to present drawings; but it is the disclosure which is required, rather than a particular mode of making the same.

Every applicant must disclose

> "the whole truth relative to his invention or discovery." (Sec. 4920, R. S.; Electric Boot and Shoe Finishing Co. *vs.* Little, 75 Federal Reporter, 276.)

Section 4888, R. S., says expressly "in the case of a machine," and by implication in other cases, that the inventor "shall explain * * the best mode in which he has contemplated applying that principle" * * .

The same description is apparently required as in a British patent, namely, such a description as

> "that the public may, after the expiration of the term, have the use of the invention in as cheap and beneficial a way as the patentee himself uses it." (page 20 of appendix to 3 Wheaton.)
>
> "The patentee suggests it as what he conceived to be the best way, apparently because the result is produced with great rapidity and certainty." (Tilghman *vs.* Proctor, 102 U. S., 707, 719.)

Petitioner's disclosure of both his process and his apparatus is essential, therefore, to a statutory specification.

III.

Petitioner could not obtain two valid patents without showing a capacity for separate use on the part of his process and his apparatus, respectively; nor could he have two valid patents with the same essential disclosure in each.

To be patentable, an invention must be shown in the patent to be useful; and what is considered at the time of application to be the best mode of carrying it into effect must be disclosed. To be patentable separately, it would seem that inventions must be shown in the patents to be separately utilizable when carried into effect in such best modes, respectively.

> "A single invention may include both the machine and the manufacture it creates, and in such cases, if the inventions are really separable, the inventor may be entitled to a monopoly of each. * * * The cases cited * * * come to this point only, that a later patent may be granted when the invention is clearly distinct from, and independent of, one previously patented." (Miller *vs.* Eagle, 151 U. S., 186, 199.)

Separate utilization would be shown if the patents, arranged in order, should none of them claim any matter necessarily disclosed in any of its predecessors, and the differences should be substantial and not colorable merely. (McClain *vs.* Ortmayer, 141 U. S., 419; McCreary *vs.* Pennsylvania Canal Co., 141 U. S., 459, 467.)

> "This was in legal effect a prior patent, since the date of the application and not the date of the patent controls in determining the effect to be given

to two patents issued at different dates to the same inventor and the order in which they are to be considered." (Washburn and Moen *vs.* Beat 'Em All Barbed Wire Co., 143 U. S., 275, 281.)

"Thus in Suffolk Company *vs.* Hayden (3 Wall., 315), it was held * * * that it is the issue date and not the filing date which determines priority to patents issued to the same inventor on the same machine." (Miller *vs.* Eagle, 151 U. S., 186, 197.)

"It is hardly necessary to remark that a patentee could not include in a subsequent patent any invention embraced or described in a prior patent granted to himself any more than he could an invention embraced or described in a prior patent granted to a third person." (James *vs.* Campbell, 104 U. S., 356, 382.)

"In Underwood *vs.* Gerber (149 U. S., 224) it was ruled that where a patentee obtained two patents on the same day, upon applications filed the same day, they could not be treated as one patent with two claims." * * * (Miller *vs.* Eagle, 151 U. S., 186, 198.)

"When a patentee anticipates himself, he cannot, in the nature of things, give validity to the second patent." (*Ibidem*, 197.)

"This conclusion is no way affected by the reservation attempted to be made in the 1879 patent * * * for the reason that the broad idea sought to be reserved is embodied in identically the same mechanical device constituting the invention and covered by the first patent, which completely occupies all the ground that was reserved." (*Ibidem*, 201.)

"All that the law requires of him is that he shall not claim as new what is covered by a former invention, whether made by himself or some other person." (O'Reilly *vs.* Morse, 15 Howard, 62, 122.)

The foundation for the rulings touching the validity of two patents to the same party appears to be:

First, in the lack of any community of interest in the holders of two patents, although issued to the same person on the applications of the same inventor;

Second, in the nature of "the exclusive right" of the Constitution (Art. I, sec. 8, clause 8) and the statute (sec. 4884, R. S.)

Claims in the same patent support each other as parts of one franchise and exclusive right. (Merrill *vs.* Yeomans, 94 U. S., 568; The Telephone Cases, 126 U. S., 1). They are not separately assignable.

> "While it is sometimes said that each claim of a patent is a separate patent, it is true only to a limited extent. Doubtless separate defenses may be interposed to different claims, and some may be held to be good and others bad; but it might lead to very great confusion to permit a patentee to split up his title within the same territory into as many parts as there are claims." (Pope Mfg. Co. *vs.* Gormully & Jeffery, 144 U. S., 248, 252.)

Claims in separate patents would not support, but antagonize, each other if they at all conflict. The patents would be separately assignable (sec. 4898, R. S.).

The "exclusive right" of the Constitution and statute is more than a bare right to exclude others; it is an exclusive right to exclude others; and it involves a right of not being excluded by others.

If A had a bare right to exclude others, there would be no invasion of that right by allowing B to exclude others also. A could exclude as much after as he could before the grant to B.

But if A has a monopoly of excluding others, then it invades his right to let B exclude on his own account.

Or, if A has a right of use and enjoyment, it invades his right to give to B the power to exclude A.

> "The plaintiff * * * was, therefore, the owner of a monopoly recognized by the Constitution and by the statutes of Congress." (Bement *vs.* National Harrow Co., 186 U. S., 70, 88.)

> "The very object of these laws is monopoly." (*Ibidem*, 91.)

> "That the grant is made upon the reasonable expectation that he will either put his invention to practical use or to permit others to avail themselves of it upon reasonable terms, is doubtless true." (*Ibidem*, 90, quoting 47 U. S. App., 146, 160.)

Two *monopolies* of exclusion, as to the same matter, are in the nature of things impossible: two rights of *mutual exclusion* would defeat the "reasonable expectation" of the last quotation and would tend to retard rather than promote the progress of science and the useful arts.

Like all property, a protected invention must be used in subjection to the police power and eminent domain and to any existing paramount rights, inchoate or perfected; but, like other property also, its use can not be impaired in favor of later or subordinate rights.

Possibly a patent might be paramount to another as to one part and tributary thereto as to another part of its subject-matter, but it can not be both paramount and tributary as to the same part or as to parts necessarily conjoined in use.

If two or more patents could be treated as forming one monopoly in legal effect, there seems to be no reason

(unless lack of consideration for the later grants) why there might not be any number of such patents on one invention, to the same patentee, if they should all be issued on the same day or should otherwise be so limited as to expire together, and should not be assignable separately. Yet in Miller *vs.* Eagle, the court referred to

> "the well-settled rule that two valid patents for the same invention can not be granted either to the same or to a different party" (151 U. S., 186, 197),

and made no exception of patents issued on the same day to the same party.

In McKay *vs.* Jackman, an original process patent, which had been sustained with some "embarrassment" over an earlier machine patent in McKay *vs.* Dibert (5 Federal Reporter, 587), was declared invalid, for one reason, because of James *vs.* Campbell (104 U. S., 356), which was after McKay *vs.* Dibert.

> "As before shown, Blake's machine patent exhibited both the shoe of his product patent and mode of construction of his process patent, to which he was no more lawfully entitled than Norton was to his second patent for what was exhibited in the first." (12 Federal Reporter, 615, 621.)

In Eastern Paper Bag Co. *vs.* Standard Paper Co., the Circuit Court dismissed James *vs.* Campbell as solely "dealing with the subject of reissues under the statute." (30 Federal Reporter, 63, 65.)

But James *vs.* Campbell was not dealing *solely* with reissues.

Norton (the assignor of Campbell) had three patents for implements (apparatus), two issued on August 9,

1859, and December 16, 1862, respectively, and the third on April 14, 1863. This last was applied for January 5, 1863, and reissued in 1870.

> "Now a mere inspection of the patents referred to above will show that after December, 1862, Norton could not lawfully claim to have a patent for the general process of stamping letters with a postmark and canceling stamp at the same time, nor for the general combination of a post-stamper and blotter in one instrument, nor for the combination of a post-stamper and blotter connected by a cross-bar, for all these things, in one or other specific form, were exhibited in these prior patents. Any such claim, therefore, in the reissued patent of 1870 must be inoperative and void, as well because the thing claimed was anticipated in former patents as because it would be for a different invention from that contained and described in the original patent." (104 U. S., 356, 382.)

Norton's prior *implement* patents were held to anticipate the *process*, as well as the general combination, notwithstanding the declaration, in the same opinion, that for the purposes of a reissue

> "A patent for a process and a patent for an implement or a machine are very different things. (*Powder Co.* vs. *Powder Works*, 98 U. S., 136.) * * a process and a machine for applying the process are not necessarily one and the same invention. They are generally distinct and different. The process or act of making a postmark and canceling a postage stamp by a single blow or operation as a subject of invention is a totally different thing in the patent law from a stamp constructed for performing that process." (James *vs.* Campbell, 104 U. S., 356, 377.)

To uphold the reissue for the process or general combination (either or both)

> "would be to grant a new and distinct privilege to the patentee" (Dunham *vs.* Dennison Mfg. Co., 154 U. S., 103, 111).
>
> "not the invention he sought to secure" (104 U. S., 356, 378)

when Norton applied for the original patent for a specific implement.

Whether the process or general combination (either or both) on the one hand, and the specific implement exhibiting the same as useful on the other, were or were not capable of being secured by separate patents would be determinable by other principles.

Had Norton's process and general combination claims been made in his 1859 patent, or had they been made in a patent prior in legal effect to the 1859 patent, they would have been unobjectionable on the ground of anticipation.

The specific form by which the process and general combination would be exhibited in such prior patent would have to be claimed in the same patent; but each subsequent specific form could be regarded as

> "A new idea * grafted upon an old invention, * distinct from the conception which preceded it, and be an improvement." (Smith *vs.* Nichols, 21 Wallace, 112, 118).

But "everything within the domain" of the prior conception "belongs to him who conceived it" (*Ibidem*). It does not matter

> "whether what preceded was covered by a patent or rested only in public knowledge and use. In neither case can there be an invasion of such domain, and an appropriation of anything found

> there. In one case everything belongs to the prior patentee, in the other to the public at large." (*Ibidem*, 119.)

This language was not used with respect to conceptions of the same inventor; but priority between such conceptions exists (pages 11 and 12 *ante*) when by obtaining separate patents the personality of the inventor has been lost in holders of separately assignable exclusive rights.

If petitioner should take two patents, each of them would necessarily be an invasion of the domain of the other and an appropriation of matter necessarily found there, in order to exhibit a thing of practical utility. The later patent would attempt to deprive the holder of the prior patent of the use and enjoyment, in the identical form therein described, of the matter claimed in such prior patent. It would destroy the monopoly of the prior patent to the use of what would be therein claimed; because the holder of the later, as well as the holder of the earlier patent, could exclude others from practicing the thing patented in said earlier patent.

In Rubber Co. *vs.* Goodyear, the court, after referring to a "machine * and the product or manufacture proceeding from it," and also to "processes and their result," said:

> "The patentability or the issuing of a patent as to one in nowise affects the rights of the inventor or discoverer in respect to the other." (9 Wallace, 788, 796.)

But the court there was dealing with divisional reissues, and not with original patents. Its remarks are *obiter;* for only one, and that the lower numbered, of the two divisions, was sustained.

The remarks themselves seem inconsistent with the later decision in Mosler Safe and Lock Co. *vs.* Mosler, Bahman & Co. (127 U. S., 354), in which the process patent was defeated by a product patent previously issued to the same inventor on a contemporaneous application. The said remarks do not in terms refer to process and machine (apparatus), respectively.

In Cochrane *vs.* Deener (94 U. S., 780), the reissues of four original patents, issued on the same day, were held valid and infringed. The first of these reissues was for the process and the others for combinations of mechanical devices. These were not necessarily (if in fact) disclosed in the process patent; because neither the "suction-pipe" of the first mechanical patent (94 U. S., 788), nor the "collecting-chamber" of the two later mechanical patents (94 U. S., 789), was necessary to the process which comprised

> "the application of the blast, and the carrying off of the fine impurities whereby the middlings are purified preparatory to regrinding after being separated from the other parts." (94 U. S., 786.)

No consideration was given by the court to the effect of disclosure in prior (process and machine) patents on later (machine) patents, under the doctrine afterwards elucidated in James *vs.* Campbell, 104 U. S., 356; Miller *vs.* Eagle, 151 U. S., 186; and other cases herein cited.

The court, in 95 U. S., 355, refused to set aside the decision in Cochrane *vs.* Deener (above) as collusive, but declared the defense to have been weak and the decision itself to be not binding as authority.

In Oval Wood Dish Co. *vs.* Sandy Creek, N. Y., Wood Mfg. Co., there were three patents granted on contemporaneous applications, the first filed and first issued for the product, the next filed and next issued for the machine, and the last filed and last issued for the process. The Circuit Court held that

> "after the dish and the machine patents there was no room for the process patent." (60 Federal Reporter, 285, 290.)

In Underwood *vs.* Gerber, the Circuit Court said:

> "This novel method of manifolding an invention was adopted, as complainants state, in order to comply with recent decisions of the Patent Office, interpreting Rule 41 of that office, and holding that when a person has invented something in an art, or, as it is ordinarily called, 'a process,' also a machine for carrying out the process, and also the manufacture or article which is produced in the operation or process by the machine, he must take out three separate patents—one for the process, one for the machine, and one for the product." (37 Federal Reporter, 682, 683 684.)

IV.

Petitioner is entitled to one patent with both sets of claims therein.

Petitioner's right to the protection being unquestioned, if both sets of claims would be valid only when obtained in the same patent, his legal right to the single patent must necessarily be conceded.

The same conclusion follows an independent consideration of the law.

The Commissioner has *authority* under the law to issue a patent with claims therein to process and apparatus, re-

spectively. They are "connected in their design and operation" (11 Howard, 587, 606). Industrially considered, they have the same "nature and design" (sec. 4884, R. S.). Hundreds, not to say thousands, of such patents have been issued. They have been uniformly sustained when they have come (as many have come) into litigation.

Silisby *vs.* Foote, 20 Howard, 378.

Merrill *vs.* Yeomans, 94 U. S., 568.

American Cotton Tie Co. *vs.* Simmons, 106 U. S., 89, 92.

The Telephone Cases, 126 U. S., 1, 537.

Hoyt *vs.* Horne, 145 U. S., 302, 304.

With some exceptions, the practice of the patent office has always been to include in the same patent process claims and apparatus claims, based on the same essential disclosure. There was no attempt until 1899 to establish the contrary practice by regulation approved by the Secretary of the Interior.

Failure to secure both in one patent gave "embarrassment" to the Circuit Court in McKay *vs.* Dibert (5 Federal Reporter, 587, 590), and apparently resulted in the defeat of the process claim in McKay *vs.* Jackman (12 Federal Reporter, 615), and the Oval Dish case (60 Federal Reporter, 285).

In James *vs.* Campbell, the court indicates with respect to each of Norton's broad claims (for the process and general combination, respectively) that

> "he might have asked to have it patented at the same time and in the same patent" (104 U. S., 370)

with the specific form of implement.

In New *vs.* Warren, the Circuit Court said with respect to a process claimed in the reissue of a machine patent

> "The description on which it was founded was in the original, and the process, if patentable at all, might have been claimed there; but it was not." (22 Official Gazette, 588, second column.)

In Merrill *vs.* Yeomans, the court said of a single patent:

> "There is no question here but that the patent is good for the second claim, for the superheating coil, with its steam pipe, &c. And we are all of the opinion that it is good for the process of distillation described in the specifications, by which the heavy hydrocarbon oils are deodorized. It is, therefore, a valid patent for two important matters well set forth and described." (94 U. S., 568, 573.)

In the Telephone Cases, the Court sustained Bell's single claim as covering both process and apparatus.

> "But this argument ignores the fact that the claim is, first for the process; and second, for the apparatus. It is to be read (1) as a claim for the method of transmitting vocal and other sounds telegraphically, as herein described, by causing electrical undulations similar in form to the vibrations of the air accompanying the said vocal or other sounds, substantially as set forth, and (2) for the apparatus for transmitting vocal or other sounds telegraphically, as herein described, by causing electrical undulations . . . substantially as set forth." (126 U. S., 1, 537.)

Not only is a process-apparatus patent authorized; but there is *no direction* in the statute making it the Commissioner's *duty* to *refuse* an application because it contains claims to apparatus and process, respectively.

Such direction has been sought

(1) in the wording of section 4886 R. S., which specifies "art, machine, manufacture or composition of matter";

(2) in a supposed necessity for strict unity in the subject-matter of each patent;

(3) in the examination system on account of a supposed greater facility of classification by having two patents with the descriptive portions of their specifications identical;

(4) in the necessity for more fees, in view of the fact that

> "The expenditures of the office, if the present system of examination is to be continued, must, from the very nature of things, continue to increase, and it will be an unfortunate day for the system when the expenditures of the Patent Office exceed the receipts." (*Ex parte* Boucher, 88 Official Gazette, 545, 548.)

In Boucher's case the Commissioner also said, with reference to a patent containing process claims and apparatus claims, that

> "if a case is ever presented for consideration which compels the decision of the question * I fail to see how the patent can either lawfully or logically be upheld." (88 Official Gazette, 546, bottom of column 2.)

This last objection goes, however, to the Commissioner's *authority*, not to his *duty* under the authority; it goes to the *mandate*, not to the *direction* of the statute. It is sufficiently covered by what has been said on pages 21, 22, *ante*.

(1.) The Constitution speaks of the discoveries of in-

ventors and obviously includes both processes and apparatus in the term "useful arts." The "art" of the statute should receive a similar construction:

> "An art may require one or more processes or machines in order to produce a certain result or manufacture (Corning *vs.* Burden, 15 Howard, 252, 267.)
>
> "To sum up the state of the art, * * * What then was the contribution of this patent to the art?" (referring to the patent for the *machine* in suit in National Cash Register Co. *vs.* Boston Cash Indicator and Recorder Co., 156 U. S., 502, 513.)

If the language of some opinions might seem restrictive, it will probably be found that no more was intended than that the patentability of a process results from the use of the word "art" in the statute.

The early acts of Congress, including the Act of 1836, were entitled "Acts to promote the progress of useful arts."

In the Act 1800, chapter 25, section 1, reference is made to

> "any invention, art or discovery."

Yet the act to which it was supplementary had the present wording of

> "art, machine, manufacture or composition of matter." (Act of 1793, chap. 11, sec. 1.)

The Act of 1790 had specified

> "any useful art, manufacture, engine, machine or device." (Chap. 7, sec. 1.)

The word "art" in all the acts, as in the Constitution itself, includes all the rest which were added in the statutes only for further assurance.

(2.) It may be argued that a patent must be for an invention (singular number), that a single invention can be expressed in a single claim, and that, therefore, the Commissioner ought to allow only one claim to be made at a time in the same application. This argument contradicts the wording of the statute, which speaks in the plural of "specifications" (next to last line of sec. 4903, R. S., and lines 13 and 14 of sec. 4622), and "any of the claims" (line 2 of sec. 4909), which allows a decree for a patent not only for the "invention as specified in his claim," but "for any part thereof" (sec. 4915, R. S., lines 8 and 9), which allows divisional reissues

> "for distinct and separate parts of the thing patented" (sec. 4916, R. S., lines 16 and 17),

which upholds the validity of a patent

> "for all that part which is truly and justly his own, provided the same is a material and substantial part of the thing patented." (Sec. 4917, R. S., lines 5 to 7)
>
> "definitely distinguished from the parts claimed without right." (Sec. 4922, R. S., line 12.)

The thing patented may consist, therefore, of "definitely distinguished parts" under the express words of the statute.

In Bates *vs.* Coe and Parks *vs.* Booth, the court said:

> "More than one patent may be included in one suit and more than one invention may be secured in the same patent" * * (98 U. S., 31, 48; 102 U. S., 96, 105.)

(3.) It is better for classification purposes not to have two patents with the same essential disclosure in each.

A given description would best be in one place only, if the guides point unerringly to that place. If the classification is so faulty that duplication is necessary, duplicate copies of any patent specification are sold by the Patent Office at five cents each.

The supposed facility for classification, if it existed, is outside the statute and is not a direction of the same to determine the Commissioner's duty. Certainly it counts for nothing against a fair performance of the inventor's contract. Under this he must originate a useful invention and disclose "the whole truth" relative thereto; it is not fair to object to his claiming whatever is new in the necessary disclosure.

(4.) Section 4886, R. S., refers to

"payment of the fees required by law"

and section 4934, R. S., gives the fee bill. Neither section can be considered a direction making it the duty of the Commissioner to manifold specifications with consequent fees, when the patent system seems to him to need all the money it can get.

The general principle of law is that what the law authorizes for an individual's benefit it commands to be done, in the absence of any contrary direction. This applies especially to inventors.

> "To promote the progress of useful arts is the interest and policy of every enlightened government. * * * This subject was among the first which followed the organization of our Government. * * * It can not be doubted that the settled purpose of the United States has ever been, and continues to be, to confer on the authors of useful inventions an exclusive right to their inven-

tions for the time mentioned in their patents. It is the reward stipulated for the advantages derived by the public for the exertions of the individual, and is intended as a stimulus to those exertions. The laws * * * ought, we think, to be construed * * * to execute the contract fairly on the part of the United States, where the full benefit has been actually received, if this can be done without transcending the intention of the statute or countenancing acts which are fraudulent or may prove mischievous." (Grant *vs.* Raymond, 6 Peters, 218, 241-242.)

"But the discoverer of a new and useful improvement is vested by law with an inchoate right to its exclusive use which he may perfect and make absolute by proceeding in the manner which the law requires." (Gayler *vs.* Wilder, 10 Howard, 477, 493.)

"The Government of the United States, as well as its citizens, is subject to the Constitution; and when it grants a patent the grantee is entitled to it as a matter of right, and does not receive it, as was originally supposed to be the case in England, as a matter of grace and favor." (James *vs.* Campbell, 104 U. S., 356, 358.)

The statute is mandatory:

"the Commissioner shall issue a patent therefor." (Sec. 4893, R. S.)

"Congress are not empowered to grant to inventors a favor, but to secure to them a right. And the term 'to secure a right' by no possible implication carries with it the opposite power of destroying the right in whole or in part." * * * (Court of Claims in McKeever *vs.* U. S., in 23 Official Gazette, 1525, column 2 of page 1526; affirmed by Supreme Court U. S., 23 Official Gazette, 1530, column 1.)

The vesting of petitioner with an inchoate right does not imply a direction to defeat or impair that right by

frittering it away by duplication of patents or by illegal and in many cases prohibitive exactions.

Section 483, R. S., neither empowers nor directs the Commissioner to make a rule as to what claims are proper in a given patent.

> "But they are to be deemed such, not because the Secretary of the Navy has announced that they will so regard them, but because they are, in fact, services performed at sea, and not on shore." (U. S. *vs* Symonds, 120 U. S., 46, 49.)

The statute only authorizes the Commissioner to regulate the *conduct* of proceedings, which themselves are statutory. Rule 41 attempts to prescribe the substantial contents of the specification and claim and so of the patent to be issued.

It is for

> "Congress to prescribe the conditions upon which it will secure to inventors the exclusive right to their inventions" (Bate Refrigerating Co. *vs.* Sulzberger, 157 U. S., 1, 43),

and when an Act of Congress authorizes a given patent upon given fees and proceedings, it is evidence that no other condition is included in the contract.

Petitioner's process is a pioneer process; and his apparatus is a pioneer apparatus. In one patent both sets of claims would be certainly sustained with the scope given to a pioneer invention. Does anybody certainly know that the courts would sustain the claim in the later patent with the same liberality, if at all?

The Patent Office

> "is more liberal in construing the differences between claims in one application than if they were

> in separate applications both as to the materiality and the patentability of those differences" (*ex parte* Griffith, 85 Official Gazette, 936, column 2 of page 937).

The opinions in McKay *vs.* Jackman (12 Federal Reporter, 615); McClain *vs.* Ortmayer (141 U. S., 419); Underwood *vs.* Gerber (37 Federal Reporter, 682; 149 U. S., 224), show that the same difference in liberality of treatment is shown by the courts.

The policy of the statute is against rather than in favor of the multiplication of patents.

This is shown by the requirement of section 4886, R. S., that the invention must be useful, of section 4888, R. S., that the process of using the invention in the "best mode" must be described (expressly in case of machines and impliedly in other cases), of section 4920, R. S., that nothing "less than the whole truth relative to his invention or discovery" must be set forth.

The idea of the law is not to restrict the subject-matter in a given patent, but to obtain the fullest information for the public benefit and to give a commensurate reward.

It is also shown by the fact that claims as such are not assignable (page 13 *ante*); and that the Commissioner may allow or refuse, but can not require, a reissue in *divisions*.

> "The Commissioner may, in his discretion, cause several patents to be issued for distinct and separate parts of the thing patented, upon demand of the applicant." * * (Sec. 4916, R. S., lines 15 to 18.)

The *demand of the applicant* is the condition precedent for any exercise of discretion by the Commissioner. The Act of 1837, chapter 45, section 5, made it necessary that

> "the patentee shall desire several patents to be issued for distinct and separate parts of the thing patented."

The *discretion* referred to in Goodyear *vs.* Waitt, 5 Blatchford, 468, and Bennett *vs.* Fowler, 8 Wallace, 445, was just this authority to refuse or to allow a reissue applicant's demand for divisional patents. It recognizes no authority in the Commissioner to demand a division against the desire of the applicant.

The statute, morever, does clearly direct the allowance in a patent of whatever claims may be proper to protect all the novelty necessarily disclosed therein.

The plain meaning of section 4886, R. S., is that whatever is essential to usefulness is, at the least, part of the thing (or invention) for which "any person," otherwise entitled, may, by a single application, "upon payment of the fees required by law, and other due proceedings had, obtain a patent."

When section 4888, R. S., says

> "and he shall particularly point out and distinctly claim * * as his invention or discovery,"

it does not mean subject to the will of the Commissioner of Patents. The plain meaning is that, after the inventor has set forth "the whole truth relative to his invention or discovery" (sec. 4920, R.S.), he has full liberty to claim whatever he regards as his own within that disclosure, subject to a traverse of his claim to novelty, originality

and present title, and that by the statutory requirement of disclosure in one specification the Commissioner is concluded from any refusal for multifariousness.

This was the view of the Commissioner in *ex parte* McClintock.

> "The inventions covered by a generic and a specific claim are distinct, although dependent, inventions. The only ground upon which one specific claim can be joined in the same patent with a generic claim is that the applicant, in order to support his generic claim, must describe some one of the species, and may claim what he must describe" (17 Official Gazette, 267, column 2 of page 271).

In Miller *vs.* Eagle, the court held that general (generic) and more limited (specific) claims could not be sustained in separate patents when "embodied in identically the same mechanical device" (151 U. S., 186, 201).

As shown above, petitioner had to invent and describe his apparatus in order to support a process claim; and the process is exhibited as useful by the aid of the identical apparatus in which his apparatus claim is embodied.

Conversely the only known use of the apparatus is to carry out the process; and this latter is, therefore, necessarily disclosed as a basis for an apparatus claim.

From the analogy, declared by the court in Bates *vs.* Coe and Parks *vs.* Booth (page 25 *ante*), between the inclusion of inventions in the same patent and the inclusion of patents in the same bill in equity, it seems to follow that the law for joinder of claims in a patent is at least as liberal as that for joining patents in a bill.

> "When a bill alleges infringement of several patents for different inventions, to escape the objection of multifariousness, it must aver that the inventions are capable of conjoint use, and are in fact so used by the defendant" (Barney *vs.* Peck and Snyder (16 Federal Reporter, 413).

The Supreme Court U. S. in express words has declared the *legal right* to one patent claiming and securing both the process and the apparatus.

> "It is fairly to be inferred from this statement, that if all which is described as new is really so, the inventor has a right to a patent for three inventions:
>
> 1. For a modification or improvement in the distilling apparatus.
> 2. For a new process or mode of distilling heavy hydrocarbon oils, by which they are deprived of their offensive odors.
> 3. For the product of this new process of distillation, namely, the deodorized heavy hydrocarbon oils fitted for use in the arts." (Merrill *vs.* Yeomans, 94 U. S., 568, 569).

> "For such discoveries and such inventions the law has given the discoverer and inventor the right to a patent—as discoverer for the useful art, process or method of doing a thing he has found, and as inventor for the means he has devised to make his discovery one of actual value. (The Telephone Cases, 126 U. S., 1, 533).

V.

The Commissioner in person has definitely rejected petitioner's application as to part of the invention, and has refused him the patent applied for.

The decision appealed from implies the patentability of both sets of claims as separate franchises; but it de-

nies the right of petitioner to both as parts of one franchise.

Two patents do not form the same thing legally as one patent with all the claims therein; and even if two were just as good as one, it seems idle to refer to a requirement of division (which refuses the one patent applied for) as other than a rejection, at least in part, of petitioner's "claim for a patent" (sec. 4903, R. S.).

Where a subject-matter which may properly be covered by one patent might also properly be protected in two patents, the option of taking two patents in place of one is the property of the inventor, no less in the case of original patents than of reissues (sec. 4916, R. S.).

But every subject-matter is not thus divisible.

> "The case against one defendant may be so entire as to be incapable of being presented in several suits" (Story's Equity Pleading, section 271*a*).

Claims may be so interconnected as to be invalid in part in separate patents (Miller *vs.* Eagle, 151 U. S., 186; pages 11–20 *ante*).

Moreover, even if two patents were (as they are not) the legal equivalent of one patent, the contract of the United States with inventors includes the perfecting of their inchoate rights upon the fees and proceedings prescribed by statute (sec. 4886, R. S.; Gayler *vs* Wilder, 10 Howard, 477, 493).

> "A defendant has no right to say that an action shall be several which a plaintiff elects to make joint. A separate defense may defeat a joint recovery, but cannot deprive a plaintiff of his right to prosecute his own suit to final determination in his own way. The cause of action is the subject-matter

> of the controversy, and that is for all the purposes of the suit, whatever the plaintiff declared it to be in his pleading" (Torrence *vs.* Shedd, 144 U. S., 527, 531; quoted in C., R. I. & P. Ry. *vs.* Martin, 178 U. S., 245, 248).

When an application for patent has been objected to, the thing in controversy is the franchise to be secured on that application. No other application is before the office. A right or an absence of right to other franchises is not in controversy.

The "alleged new invention or discovery" to be examined under section 4893, R. S., is the measure of the franchise and is "for all the purposes of the" application, whatever the applicant declares it to be in his specification.

The Commissioner's decision upon petitioner's application can be supported (if at all) only upon the ground that petitioner is not "justly entitled under the law" (sec. 4893, R. S.) upon the application presented "to receive a patent for the invention, as specified in his claim" (sec. 4915, R. S.). Said decision goes even further than this, however, for it denies petitioner's right to a patent for said invention on any application.

The Commissioner will grant a patent on application for part of that invention; but the statute itself distinguishes the invention from "any part thereof" (sec. 4915, R. S., page 25 *ante*).

The protection of both sets of claims in one patent, as parts of one franchise and exclusive right, is of the essence of petitioner's contract with the United States. It is even more than

> "a right of substantial value * * inseparably connected with the cause of action." (*In re* Connaway 178, U. S., 421, 427, quoting B. & O. R. R., *vs.* Joy, 173, U. S., 226, 228).

The sole purpose of the Commissioner's decision is the cancellation of part of the claim; and consequently a rejection of the application with respect to the part to be canceled. It affects the substance of the grant to be made when the application matures to patent.

VI.

The Commissioner's decision is not interlocutory but final.

The form in which the Commissioner has expressed his decision does not affect its status as interlocutory or final. (Collins *vs.* New Hampshire, 171, U. S., 30, 34; Commissioner *vs.* Whitely, 4 Wallace, 522; Potter *vs.* Beal, 50 Federal Reporter, 860.)

A decision is interlocutory when

> "made before final decision and for the purpose of ascertaining matter of law or fact preparatory to a final decree." (Richmond *vs.* Atwood, 52 Federal Reporter, 10, 20–21).

It does not appear that any further consideration need be given to the case; nor that the Commissioner is deliberating or wishes to deliberate further, respecting petitioner's title to the patent (franchise or document) for which he has applied.

Nothing is reserved by the Commissioner if petitioner will not conform with the official requirement, and the only thing left for petitioner under the decision is to

cancel a part of his claim. The most complete anticipation of such part could accomplish no more, so far as the present application is concerned.

The Commissioner *intends* his decision to be without prejudice to the presentation of the canceled claims in a separate application; but the Commissioner's authority might be exceeded in so entertaining them; and even if not, his decision denies petitioner's just title to the patent applied for.

The "title of the claimant" to be ascertained by the statutory "investigation" (112 U. S., 67) or "examination" (sec. 4893, R. S.) is not some abstract right of protection, but the one patent (document and franchise) which petitioner asks by his application. The Commissioner has deliberately and definitely said he will in no event grant this unless directed by the courts to do so.

As petitioner understands, he has also refused in part the protection which he concedes to be petitioner's just reward; since that protection can fully be secured under the statute only by a single franchise, granted and evidenced by one patent document, which shall include both sets of petitioner's claims.

The Primary Examiner said that his determination was "final" (exhibit record, pages 21, 22 and 26), and the Commissioner sustained his ruling.

Moreover, the Primary Examiner dismissed the application presented, by refusing to entertain it further for any purpose; and the Commissioner sustained that also.

The Commissioner refused to allow the appeal to be heard, which petitioner took to the Examiners-in-chief.

He refused to give any relief.

The return says that

> "There had been no consideration of or action upon the merits of the application" (page 3).

Whitely made the plea that no examination had been made; and the then Commissioner said

> "in his answer to the rule that he could not examine the application, because none had been filed in the Patent Office.
>
> "The position is untenable. * *
>
> "The relator had done all in his power to make his application effectual, and had a right to consider it properly before the Commissioner.
>
> "It was so * * The Commissioner found the question, whether the assignee was such a one as the law entitled to a reissue, lying at the threshold of his duties? * * * Having resolved it in the negative, there was no necessity for him to look further into the case. Entertaining such views it would have been idle to do so. *The question* was vital to the application, and its resolution fatal, so far as he was concerned. Only a reversal by the tribunal of appeal could revive it, and cast upon him the duty of further examination." (Commissioner *vs.* Whitely, 4 Wallace, 522, 532-533.)

Here the question is not one of parties, but of subject-matter. The Commissioner finds that petitioner's "alleged new invention or discovery" (sec. 4893, R. S.) includes

> "more devices than could properly be made the subject of a single patent." (Sessions *vs.* Romadka, 145 U. S., 29, 40).

"Entertaining such views," why should he "look further into case?" "*The question* was vital," and its adverse resolution fatal, so far as the Commissioner is concerned.

He asserts an authority to determine legislatively what can or can not be included in a single patent; and this authority is invalid; but petitioner can question it only by proper legal proceedings.

The dismissal of a bill for multifariousness is a final decree. (Walker *vs.* Powers, 104 U. S., 245; Gaines *vs.* Chew, 2 Howard, 619.) An order sustaining a demurrer for multifariousness with leave to amend would not be a final decree in a strict sense; although it might be in the nature of a final decree.

Possibly the distinction between a decree of dismissal and an order sustaining a demurrer with leave to amend was in the mind of the Court of Appeals; if so, it is to be regretted that it was not expressed in such manner that there would be no doubt about the Commissioner's withdrawing from the position that petitioner can do nothing more with the present application in the Patent Office, without cancellation of part of the claim.

Had petitioner attempted by mandamus to compel further action of any kind in the Patent Office, he might, on the one hand, have lost the benefit of the appeal which the Court of Appeals refused to hear and, on the other, have failed to obtain any relief through mandamus on the ground that the remedy was appeal. (Commissioner *vs.* Whitely, 4 Wallace, 522.)

The Commissioner's decision is, however, more than an order sustaining a demurrer for multifariousness under the current practice in the courts. One difference is that any further order by the Comm issioner would be nugatory. Under the present order petitioner can do

one thing only with his application in the Patent Office, that is to say, he can cancel a part of the claim; and no further order of the Commissioner could abridge this right to disclaim in order to avoid the objection of multifariousness. It exists even after patent (Sessions *vs.* Romadka, 145 U. S., 29, 40).

Should Congress give to every complainant, whose bill should be dismissed for multifariousness, the right of reinstatement by disclaimer, a formal order of dismissal would be a mere superfluity. By leave of the Appellate Court, a bill dismissed for multifariousness can now be amended (Gaines *vs.* Chew, 2 Howard, 619, 653).

Another difference is that applications for patents can be *finally* refused, that is, "twice rejected," as to *part* of the claim (sec. 4909, R. S.); and in such case the rest of the claim is not dead, but only in suspense. So far as appears, there is nothing to prevent the immediate allowance of petitioner's application, with one set of his claims. The other set stands rejected under the Commissioner's order. The finality of that rejection is not affected by the fact that the order does not name the particular set to be canceled. Petitioner would be obliged to determine this in complying with the order.

The preliminary rejection under section 4903, R. S., is interlocutory, because "the Commissioner" is required to "order a re-examination of the case"; but the Examiner did twice make such re-examination of petitioner's case (pages 19-21 of exhibit record); and the Court of Appeals points to no statute giving any further right of examination to petitioner. The Examiner did, and the Commissioner does, expressly deny any such right.

It is conceived, however, that the right to a re-examination could be waived. The Commissioner gives his decision the effect of a final order; and petitioner has taken the same view of it.

The return says that the

> "ruling was made by the Commissioner of Patents upon an interlocutory petition to him under Rule 145 * * * not * * * on an appeal, under section 4910 of the Revised Statutes." (Pages 2 and 3.)

But if the said ruling shows a definite determination of the Commissioner (subject only to the courts) in no event to allow to petitioner the patent applied for, it was a final decision of rejection, however it may have been made.

The Commissioner claims, and, in fact, exercises (pages 41 and 42, *post*), the authority to determine the merits of any application at any stage of the case.

If there has been any irregularity, it is on the part of the Patent Office. If the irregularity is such as to vitiate and make void in law the said ruling, that is only an additional matter for determination on the appeal.

Petitioner actually took an appeal to the Board of Examiners-in-chief (sec. 4909, R. S.), but the Examiner withheld it, and the Commissioner sustained his action. The tenth, twelfth and fourteenth of the reasons of appeal (Appendix, pages vi, vii and viii, *post*) assigned as error his so doing. This question was, therefore, one of those before the Court of Appeals for its decision.

The only possible relief when the Examiner withheld the appeal under section 4909, R. S., was to apply to the

Commissioner in person. The petition of appeal was not interlocutory, but with respect to two, if not three, "final" decisions of the Examiner. It was justified by section 481, R. S., without regard to Rule 145, or by necessity, if section 481, R. S., should not apply.

The Commissioner acted in person on Whitely's case, without reference to the Primary Examiner and the Examiners-in-chief. Both these tribunals then existed. The Board of Examiners-in-chief was established by Act of 1861 (172 U. S., 585). Whitely's application was filed 1863 (4 Wallace, 522). The court held that Whitely had the right to appeal.

The Act of 1836, chapter 357, section 7, in force in Whitely's day, provided that

> "the Commissioner shall make, or cause to be made, an examination."

Section 4893, R. S., provides that

> "the Commissioner of Patents shall cause an examination to be made."

Then he was

> "to superintend, execute and perform all * * * acts and things * * * provided * * * by law." (Sec. 1 of Act of 1836.)

Now he is required to

> "superintend or perform all duties * * * directed by law." (Sec. 481, R. S.)

The Supreme Court D. C. (two judges dissenting) held with reference to section 481, R. S. (the law now in force), that

> "The law designates the judge who is to superintend and he may even do all the work. * * * In

> the very inception of a matter for a patent the Commissioner controls the application, by express enactment, and he is the officer to cause an examination to be made, and could even do it himself. Section 4893——." (8 Official Gazette, 46, first column of page 48.)

The same court's opinion on a prior hearing, with the opinions of the dissenting judges, can be found in 7 Official Gazette, 559, 562.

See also the Commissioner's opinion in Anderson and Dyer *vs.* Lowry (89 Official Gazette 203), and that of the Court of Appeals, D. C., in Drawbaugh *vs.* Commissioner of Patents (77 Official Gazette, 313, column 1 of page 316).

If, then, as these decisions in effect hold, the law touching the examination of applications for patents is the same now as it was in Whitely's day, the decision in 4 Wallace, 522, is clear authority for the appeal which petitioner took to the Court of Appeals.

On the other hand, suppose the law to be changed so that now the Commissioner has no original and no appellate authority, except on appeal from the decision of the Examiners-in-chief (sec. 4910, R. S.), his actual decision is none the less a definite denial in fact of petitioner's title.

A decision to be final (with reference to appeal) does not have to be correct nor even to be authorized. Appeals are constantly taken to review questions of jurisdiction, and the practice is not to dismiss the appeal but to reverse the decree, if the court below exceeded its jurisdiction.

The Commissioner has charge of petitioner's papers (sec. 481, R. S.). He is the head of the Patent Office. When he makes an adverse decision, whether authorized or not, it in fact bars the "title of the claimant" until it is reversed or set aside.

Bernardin contended

> "that the decree of the Court of Appeals was utterly void because of the unconstitutionality of the statute by which it was empowered to exercise jurisdiction" (U. S. *ex rel.* Bernardin *vs.* Duell, 172 U. S., 576, 582);

But the court said

> "we think, that, under the circumstances, the remedy by appeal existed." (*Ibidem.*)

Yet the statute only allowed appeal from a "final judgment or decree of the said Court of Appeals." (Sec. 8 of act approved February 9, 1893.)

The authority of the Commissioner to make the ruling sought to be reviewed is a proper subject of inquiry by the Court of Appeals on every appeal, and a decree of affirmance necessarily sustains that authority. If lack of authority should appear, the right decision is not dismissal (which has much the effect of affirmance), but reversal.

An absence of authority to make a given decision certainly does not make the same interlocutory.

The right to appeal, as from a final decision, would exist, even if there should be a concurrent remedy by mandamus (Sandford Fork and Tool Co., 160 U. S., 247; Union Steamboat Co., 178 U. S., 317).

Petitioner contends not merely that the Commissioner's decision is erroneous, but that it is null and

void, because it arrogates to the Commissioner powers conferred on Congress and not delegated, if capable of delegation, namely, the power to limit legislatively the scope of franchises to be obtained on given applications and proceedings.

This contention is consistent with the refusal of a patent because it would cover more devices than would be proper in one patent under the statute; but it denies that the Commissioner may cut loose from the statute and refuse a patent on application, in whole or in part, upon reference to conditions, rules, or what not, originating with himself.

It also denies any authority in the Commissioner at any time to raise an objection of multifariousness, on account of two sets of claims, when the same matter is necessarily disclosed as a basis for each set (pages 5, 11–20, 30–32, *ante*), or when there is no showing of a capacity for separate use.

The plain meaning of the statute is that whatever is necessarily first disclosed in a given specification, should be claimed in the same. To separate the claims thereto is exceptional, if not intolerable.

Petitioner also contends that, if the Commissioner's decision is within his authority, it is erroneous.

None of petitioner's contentions, however, admits said decision to be interlocutory rather than final.

The Commissioner denies the legal right of any applicant in any case to have given claims in a given patent upon a given necessary disclosure. He claims to exercise, in fact does exercise, and in petitioner's case is ex-

ercising, an absolute and autocratic authority to control the claims in applications for patents. The whole matter rests, he contends, in his executive discretion, which can not be controlled by the Court of Appeals, D. C. He does not, when so acting, interpret the will of Congress; but he is himself both author and interpreter of the conditions under which the inventor can or can not secure given claims in the same patent.

For this reason he moved to dismiss petitioner's appeal.

It was not because his decision was interlocutory, but because he considered it so final and conclusive that the Court of Appeals could not look at it.

He is understood to hold that no patent, however multifarious, would be invalid on that account; and, therefore, he is at liberty to do as seems to him best in requiring division.

But this view of the Commissioner's authority has not always obtained in the Patent Office.

> "If several distinct inventions were embraced in the same patent, it would be invalid for that reason. When the office, therefore, directs an applicant to divide his application, it is not simply for the purpose of requiring applicant to conform to the classification of the office, nor because it will require more time to examine the matters embraced in the application, but because the patent can cover only a single invention and be valid" (*ex parte* Van Matteson, 24 Official Gazette, 389, lower part of column 2.)

The requirement of division must either be based on this ground of invalidity or upon some *direction* of the

statute to which the Commissioner can refer. An autocratic authority in the Commissioner on so vital a matter is not and could not constitutionally be given either to an executive or to a judicial officer.

When the Commissioner acts to require division, his action, if lawful at all, is judicially

> "to interpret and give effect to the statute as passed by Congress" (Bate Refrigerating Co. *vs.* Sulzberger, 157 U. S., 1, 43.)

The Commissioner's decision is final, on his part; for, if sustained on appeal, he

> "would have nothing to do but execute the judgment or decree * * already rendered" (Kingman *vs.* Western Mfg. Co., 170 U. S., 675, 680, quoting Bostwick *vs.* Brinkerhoff, 106 U. S., 3.)

It need not bar another application for the canceled claims. (Colorado Eastern Railway Co. *vs.* Union Pacific Ry. Co., 94 Federal Reporter, 312.)

VII.

Further proceedings in the Patent Office would be fruitless.

> "If it appear that the party who makes an absolute refusal intends to put an end to the contract so far as performance is concerned, and that the other party must accept this position, why should there not be speedy action and settlement in regard to the rights of the parties?" (Roehm *vs.* Horst, 178 U. S., 1, 19).
>
> "It is true the order does not in terms dismiss the bill, but that was its necessary result. It denied the relief sought and there was no other course open to the appellant. * * * * To proceed

further would have been fruitless" (McNiece *vs.* Eliason, 78 Maryland, 168, 175, sustaining appeal by complainant on order allowing demurrer).

> "There are the general provisions as to what shall constitute an application and when it shall be completed, and it must be inferred when in the first step in an examination a vital objection to form is seen that no further examination is to be had as to the merits until it is corrected. * * * The question of division would present a vital objection—that is, if there appeared an application containing claims for two separate and distinct inventions." (*Ex parte* Mill, 40 Official Gazette, 918, column 1 of page 920.)

> "*The question* was vital to the application, and its resolution fatal, so far as he was concerned." (Commissioner *vs.* Whitely, 4 Wallace, 522, 533.)

The Patent Office is carrying out its own view of petitioner's contract; it has assumed powers it does not have, and has otherwise erred; it has definitely denied the legal rights which petitioner claims under said contract. "Why should there not be speedy action and settlement in regard to the rights" of petitioner?

VIII.

The Court of Appeals had and has jurisdiction to hear and determine petitioner's appeal.

Section 9 of the act approved February 9, 1893 (Code D. C., sec. 228), transfers to the Court of Appeals the jurisdiction which the Supreme Court, D. C., had to

> "hear and determine all appeals from the decisions of the Commissioner of Patents, in accordance with the provisions of sections forty-nine hundred and

eleven to section forty-nine hundred and fifteen, inclusive, of chapter one, title LX, of the Revised Statutes." (Sec. 780, R. S. D. C.)

Section 11 of the Act approved February 9, 1893, provides

> "That the said Court of Appeals shall have power to issue all necessary and proper remedial prerogative writs in aid of its appellate jurisdiction."

Section 4911, R. S., omitting a reference to interferences, now repealed, reads:

> "If such party * * * is dissatisfied with the decision of the Commissioner, he may appeal to the Supreme Court of the District of Columbia, sitting in banc."

Section 4912 requires notice and reasons of appeal.

Section 4913 provides for certified copies, a return by the Commissioner, and an examination under oath of "the Commissioner and the examiners."

Section 4914 provides that the court shall revise the decision appealed from on "the points set forth in the reasons of appeal," and that the court's decision "shall govern further proceedings in the case," but shall not "preclude any person interested from the right to contest the validity of the patent."

Section 4915, in part, provides that

> "Whenever a patent on application is refused, either by the Commissioner of Patents or by the Supreme Court of the District of Columbia upon appeal from the Commissioner, the applicant may have remedy by bill in equity; and the court * * * may adjudge that such applicant is entitled, according to law, to receive a patent for his invention, as specified in his claim, or for any part thereof, as the facts in the case may appear."

The other sections which seem most important touching the right of appeal, as distinguished from the right to the patent, are:

"Section 481. The Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law; * * * ."

"Section 4893. On filing of any such application and the payment of the fees required by law, the Commissioner of Patents shall cause an examination to be made of the alleged new invention or discovery; and if on such examination it shall appear that the claimant is justly entitled to a patent under the law, and that the same is sufficiently useful and important, the Commissioner shall issue a patent therefor."

"Section 4894. All applications for patents shall be completed and prepared for examination within one year after the filing of the application, and in default thereof, or upon the failure of the applicant to prosecute the same within one year after any action therein, of which notice shall have been given to the applicant, they shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable."

Section 4895 allows issue of the patent to an assignee.

Section 4896 allows the representatives of a dead inventor to obtain a patent

"on the same terms and conditions as the same might have been claimed or enjoyed by him in his lifetime."

"Section 4903. Whenever on examination, any claim for a patent is rejected, the Commissioner shall notify the applicant thereof, giving him briefly the reasons for such rejection, together with such

information and references as may be useful in judging of the propriety of renewing his application or of alterting his specification; and if, after receiving such notice, the applicant persists in his claim for a patent, with or without altering his specifications, the Commissioner shall order a re-examination of the case."

"Section 4909. Every applicant for a patent or for the reissue of a patent, any of the claims of which have been twice rejected, and every party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal."

"Section 4910. If such party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person."

Sections 4911 to 4915, inclusive, are given above.

The Court of Appeals, under the strictest construction of the law, has jurisdiction of petitioner's appeal, unless a decision is necessary by the Examiners-in-Chief, intermediate the Primary Examiner and the Commissioner in person.

He is an "applicant for a patent" (sec. 4909); he is, therefore, "such party" as is referred to by section 4911; but if the word "such" necessarily implies two rejections of at least a part of his claims, then a part of his claims were "twice rejected" by the Primary Examiner (exhibit record, pages 15–21).

The objection of want of parties, which the Commissioner opposed to Whitely's application, was not recited in section 7 of the Act of 1836, and Whitely's application had not been "twice rejected" by the Primary

Examiner (as specified in section 3 of the Act of 1861); yet the court held that appeal would lie (4 Wallace, 522, 533).

The objection in Whitely's case was not to the subject-matter of the application (in other words, it was not to the "alleged new invention or discovery"), but only to Whitely's title on the application filed to obtain protection therefor. Here the objection is to Frasch's "alleged new invention or discovery" and to his title lawfully to protect the same in both its parts on the application under consideration.

No decision of the Examiners-in-chief was rendered; but petitioner took an appeal to them, which the Commissioner suppressed; and the decision to suppress was itself proper subject of appeal. The right to have such proceedings in the Patent Office as will protect the Court of Appeals' jurisdiction over the quasi-judicial decisions of the Patent Office is conferred by statute on the court (sec. 11, page 48, *ante*).

The statute does not require a separate proceeding in order that the Court of Appeals should direct a proper procedure in the Patent Office (Oliver *vs.* Felbel, 100 Official Gazette, 2384, lower part of column 2 of page 2386).

Moreover, if the Commissioner had authority to make a decision rejecting petitioner's application, without regard to the Examiners-in-chief, the plain meaning of the statute is that the Court of Appeals has jurisdiction to revise said decision. It was not the intention of Congress to put the appellate jurisdiction of the Court

of Appeals in the power of the Commissioner, through the control which he has over other officers of the bureau.

On the other hand, if the Commissioner has no valid authority of rejection except on appeal from the Examiner-in-chief, the statute gives jurisdiction to the Court of Appeals to revise said decision, to reverse it for want of authority and to remand the case for further consideration in the Patent Office in due order of appeals. See tenth, twelfth and fourteenth of petitioner's reasons of appeal (Appendix, pages vi, vii and viii, *post*).

An appellate court has jurisdiction to pass upon the lower court's jurisdiction; and its adverse determination thereof would not take away the jurisdiction of the Appellate Court to hear and determine the appeal (Nashua & Lowell Ry. Corp. *vs.* Boston & Lowell Ry. Corp., 51 Federal Reporter, 929, 930).

The principal statute to be considered here is section 780, R. S., D. C.; for it confers the jurisdiction, and sections 4911 to 4915, R. S., are brought in by reference.

The Court of Appeals is to hear all appeals from the decisions of the Commissioner of Patents; it is to hear and determine them in accordance with sections 4911 to 4915, R. S.

This last section refers to a bill in equity; but it must be construed as part of the enactment giving jurisdiction. It shows, among other things, that the Court of Appeals exercises equitable and not common law jurisdiction when an appeal is taken to it from a decision of the Commissioner of Patents.

It also shows that its jurisdiction is complete, touch-

ing any and every refusal of "a patent on application" by the Commissioner, whether for the whole of the "invention, as specified in his claim, or for any part thereof." As shown above (pages 50–52, *ante*), the same result follows from a consideration of section 4911, R. S.

The distinction between executive and judicial functions can not be overlooked; but it plainly appears that Congress, in its contracts with inventors, stipulates a right to (1) the protection; (2) the franchise through which the protection is afforded; (3) the patent document which grants and evidences the franchise, and (4) the fees and other proceedings to obtain the patent document. The determination of the existence and scope of these stipulations is a judicial function.

Considering the inchoate right to a patent franchise as property, of which "No person * shall * be deprived * * without due process of law" (5th amendment to Constitution), it is most fitting that the existence and scope of such right (when claimed) should be ascertained by courts of record.

Whatever may be the distinctions between perfected and inchoate rights, and whatever might be the constitutionality of an act entrusting the judicial duty of ascertaining an inventor's rights exclusively to executive officers, Congress plainly intended to give each inventor every appropriate remedy for the enforcement by judicial process of his inchoate right to a given franchise and exclusive right.

> "It will have been seen that in the gradual development of the policy of Congress in dealing with the subject of patents, the recognition of the

> judicial character of the questions involved became more and more pronounced." (U. S., *ex rel.* Bernardin *vs.* Duell, 172 U. S., 576, 588.)

The right to appeal is a beneficial one and "should be liberally construed" (4 Wallace, 532), especially when it involves the judicial ascertainment of property rights, in conformity with the Constitution and the amendments thereto.

The power of the Court of Appeals, instead of being a limited one, is very large and extends to every quasi-judicial act of the Commissioner of Patents (Opinion of the Assistant Attorney-General, approved by the Secretary of the Interior, in Poole *vs.* Avery, 87 Official Gazette, 357).

The statutory words conferring jurisdiction are "all appeals" (sec. 780, R. S. D. C). The presumption is that the Commissioner's decisions are quasi-judicial and intended to be reviewable by the Court of Appeals. The burden is on the Commissioner to establish the contrary, and he should be required to make out so clear a case that the authority of the Secretary of the Interior could safely be invoked (Poole *vs.* Avery, *ante*).

The Act does not use the words "final decision"; and if it did, a decision which bars petitioner from any further conduct of his case before the Patent Office is final.

At the least, the court's jurisdiction extends to every decision by the Commissioner in person restricting the subject-matter and scope (either or both) of the grant to be made on an application under examination.

The Court of Appeals could give, and in any view of

the case ought to have given, some relief. It ought to have reopened a door into the Patent Office, if felt compelled otherwise to refuse for a time a determination by f of petitioner's title to the patent applied for.

IX.

Mandamus to the Court of Appeals is petitioner's proper remedy.

When an appellate court dismisses an appeal for supposed want of jurisdiction to hear and determine the same, the remedy is mandamus (Insurance Co. *vs.* Comstock, 16 Wallace, 258; R. R. *vs.* Wiswall, 23 Wallace, 507).

Even in the case of a court of first instance,

> "if the court, after sufficient service on the defendant, erroneously declines to take jurisdiction of the case or to enter judgment thereon, a writ of mandamus lies to compel it to a determination of the case, except when authority to issue a writ of mandamus has been taken away by statute." (In re Grossmayer, petitioner, 177 U. S., 48, 49.)

The court has power to issue mandamus to the Court of Appeals, D. C., for it is "appointed under the authority of the United States." (Sec. 688, R. S.) It is not necessary that there should be an appeal in reference to the matter to which the mandamus relates. (*Ex parte* Bradley, 7 Wallace, 364, 376.)

In the present case, if the Court of Appeals had sustained the authority which the Commissioner exercises in fact, but unlawfully, petitioner could have appealed (sec. 8 of Act approved February 2, 1893, Code D. C.,

sec. 233), on the ground that the validity of an authority exercised under the United States was called in question, and also the validity of a statute of the same, if any exist, granting such absolute and autocratic power to the Commissioner of Patents. Or petitioner could have applied for a writ of certiorari. (Act approved March 3, 1897, Code D. C., sec. 234).

In U. S. *ex rel.* Bernardin *vs.* Duell, the decisions of the Court of Appeals, D. C., on Patent Office appeals were held to be reviewable by the Supreme Court of the United States the same as other decisions of that court.

> "The validity of the act of Congress allowing an appeal to the Court of Appeals in interference cases was necessarily determined when that court went to judgment, yet no attempt was made to bring the case directly to this Court * * * . * * * ; and we think that, under the circumstances, the remedy by appeal existed * * * ." (172 U. S., 576, 581–582.)

Neither the claim of autocratic authority by the Commissioner, nor the rightful exercise of such authority, could deprive the Court of Appeals of jurisdiction to hear petitioner's appeal.

> "The very point to be decided upon an appeal here is whether they had such discretion and whether they exercised it in a manner that cannot be reviewed in this court * * * whether in the exercise of what the court asserts to be its discretionary power it has invaded established rights of the petitioners in this case contrary to law." * * * (Farmers' Loan and Trust Co., 129 U. S., 206, 215.)

> "But when the legislature proceeds to impose on that officer other duties, when he is directed peremptorily to perform certain acts; when the rights

> of individuals are dependent on the performance of those acts, he is so far the officer of the law; is amenable to the laws for his conduct, and can not at his discretion sport away the vested rights of others." (Marbury *vs.* Madison, 1 Cranch, 137, 165-166.)

The Court of Appeals did not pass upon the very broad authority which the Commissioner claims, but refused to inquire into it.

As the issue of the writ of mandamus rests in the sound discretion of the court (*In re* Key, 189 U. S., 84), it has seemed advisable to show somewhat in detail (1) that the writ asked by petitioner is in aid of a clear right, to wit, the right to one patent with claims therein to all the patentable matter necessarily first disclosed by petitioner in such patent; (2) that such right has been denied by the Patent Office after all the consideration which it is in the power of petitioner to obtain from the officials thereof; (3) that Congress plainly intended to provide for petitioner a remedy by the appeal which he has taken.

Petitioner seems to have no remedy but mandamus in some form. Proceedings in mandamus to compel further action on the part of the Patent Office might or might not be entertained by the Supreme Court of the United States, when they reached it, if petitioner had not first exhausted or have shown himself to be without the remedy of appeal to the Court of Appeals.

A right to mandamus and to appeal may exist concurrently to a limited extent (Union Steamboat Co., 178 U. S., 317; Sanford Fork and Tool Co., 160 U. S., 247); but, inasmuch as the entire case can only be reviewed on appeal, the latter is preferable for this reason, as also because it is the ordinary remedy.

X.

Petitioner is entitled to some remedy by judicial process.

A remedy is the correlative of a right. Congress by the whole trend of its legislation intends to give inventors the remedy of judicial process to enforce the perfecting of their inchoate rights (Commissioner *vs.* Whitely, 4 Wallace, 522; U. S. *ex rel.* Bernardin *vs.* Duell, 172 U. S., 576).

Petitioner's dilemma under the Commissioner's decision is that he must either (1) abandon a part of his claim or else (2) take a subsequent patent for matter necessarily disclosed in a prior patent and not shown to be capable of separate utilization.

This dilemma is due to the fact that the patent acts require of petitioner a disclosure of both process and apparatus, as a basis for making his process claims and the same essential disclosure as a basis for making his apparatus claims.

Moreover, he can not show any capacity for separate use, because his process requires some apparatus, and the apparatus disclosed is the only apparatus he knows to be suitable, while he at present knows of no use for his apparatus except to carry out his process.

The law does not make this dilemma for petitioner, but the Commissioner of Patents. Surely there is a remedy whereby petitioner may be relieved of choosing between the horns.

> "If it is found that errors in pleading have been committed by either party injurious to his rights,

> an opportunity would certainly be afforded him to correct in some subsequent proceeding, so as to bring the real points in controversy fairly before the court." (Smith *vs.* Ely, 15 Howard, 137, 142.)

In Insurance Co. *vs.* Comstock (16 Wallace, 258, 270-271), the court dismissed a writ of error, but gave to the opinion the effect practically of a writ of mandamus.

In Mutual Life Insurance Co. *vs.* Phinney, 178 U. S., 327, a Circuit Court of Appeals, for supposed want of juisidiction, had dismissed a writ of error. On certiorari, the Supreme Court U. S. sustained the jurisdiction of the Circuit Court of Appeals; but there seems to have been no question raised as to whether mandamus was not the proper proceeding

If certiorari was the proper remedy to correct error on the part of the Court of Appeals, the present petitioner has furnished everything needed for certiorari proceedings; and it is prayed that his petition be given effect as an application for certiorari or as whatever pleading might be the proper remedy for the case, which in its present condition seems at a stand still between the patent office and the Court of Appeals.

Even if the proper remedy is mandamus directed to the Commissioner of Patents, the final arbiter in the matter would be the Supreme Court U. S.; and the present record affords substantially everything which an appeal in mandamus procedings could afford.

The case is strictly *ex parte*. There is no contestant.

Public and private interests alike will be affected favorably and not injuriously by an early and full determination of the questions involved.

A remedy is demanded *ex debito justitiae*, if for no other reason.

Wherefore, petitioner prays that the court issue a peremptory writ of mandamus directing the Court of Appeals, D. C., to hear and determine petitioner's said appeal. He also prays that the court grant any other or further relief which may be proper in the premises.

CHAS. J. HEDRICK,
Attorney for Herman Frasch, Petitioner.

APPENDIX.

Reasons of Appeal from decision of Commissioner of Patents to Court of Appeals, District of Columbia (exhibit record, pages 1-7).

First. The authority exercised by the Commissioner of Patents, with the approval of the Secretary of the Interior, in establishing or attempting to establish rule 41 is invalid, because unconstitutional. Among the many grounds of unconstitutionality the following few are here set forth by way of example, namely:

A. The rule is in contravention of section I of article I, which section vests all the legislative powers of the Constitution in Congress and not in any executive officer or officers.

B. The rule is in contravention of that paragraph of section VIII of article I, which paragraph grants the power to secure to inventors the exclusive right to their respective discoveries, but said rule operates to deprive inventors whose discoveries cover new processes, requiring new apparatus to make the same practically useful, of the exclusive right to either their said new processes or their said new apparatus, although said processes and said apparatus must both be disclosed by such inventors in order to obtain any exclusive right whatsoever.

C. The rule is in contravention of the clause of article V of the amendments to the Constitution, which forbids any person to be deprived of property without due process of law, inasmuch as by the mere will of an executive officer or officers it deprives the inventors mentioned in paragraph B above of their property in a part of their said discoveries.

Second. The authority exercised by the Commissioner of Patents, with the approval of the Secretary of the Interior, in establishing or attempting to establish rule 41

is invalid, because without warrant of law. Among the many grounds upon which such absence of legal warrant can be urged, the following few are set forth by way of example, namely:

A. The Revised Statutes distinguish clearly between (1) the lawful subject-matter of a patent, (2) the statutory proceedings for obtaining a patent, and (3) the conduct of the said statutory proceedings; the only authority given by any act of Congress is to regulate the *conduct* of the statutory proceedings, but rule 41 is directed toward ascertaining and prescribing what shall be the lawful subject-matter of a patent.

B. Congress has not delegated to the Commissioner of Patents, nor to any executive officer or officers, the making of such a rule as is rule 41.

C. In fact, under the Constitution, Congress could not make such a delegation of power, as the enactment of the said rule would be an exercise of the legislative power.

Third. The authority exercised by the Commissioner of Patents, with the approval of the Secretary of the Interior, in establishing, or attempting to establish, rule 41, is invalid, because the said rule is unreasonable. Among the many grounds of unreasonableness, the following few are here set forth by way of example, namely:

A. The inventor *must* invent and *must* disclose matter which the said rule will not allow him to claim in the very patent wherein such disclosure *must* be made, and as a condition precedent to which the said matter *must* be invented.

B. The rule forbids the claiming in one patent of matters which repeated decisions of the Supreme Court of the United States have held to be the proper subjects of distinct claims in the same patent, which that tribunal has never recognized as proper subject-matter for separate patents, and which seem by the pronouncements of the same tribunal to be forbidden to be claimed in separate patents.

C. The rule contemplates two patents identical in the subject-matter invented and disclosed and differing only in the claim.

Fourth. The authority exercised by the Commissioner of Patents, with the approval of the Secretary of the Interior, in establishing, or attempting to establish, rule 41 is invalid, because said rule is inconsistent with law. Some of the many grounds of its inconsistency with law are hereinabove set forth and need not be repeated. In addition, the following are here set forth, likewise by way of example, namely:

A. Congress having legislated with respect to the subject matter of a patent, any alteration, by enlargement or restriction, or otherwise, of the statutory provisions is inconsistent therewith.

B. Congress having set forth certain fees and proceedings by which an exclusive right may be secured to one or more specified inventions or discoveries or inventions and discoveries, a rule demanding two or more sets of fees and two or more proceedings is inconsistent with the congressional enactments.

C. The rule forbids what Congress has authorized, namely, one patent for both a new process and the new apparatus by which such process is made of practical usefulness.

D. The rule enjoins what the law forbids, to wit, the establishment of mutually exclusive monopolies.

E. The rule enjoins what the law forbids, to wit, the limitation of the vested and inchoate rights under one patent by a patent subsequent thereto, both in order of issue and in legal effect.

F. The rule contemplates what the law forbids, to wit, the limitation of the inchoate rights of the public under a patent by a second patent subsequent thereto, both in date of issue and in legal effect.

G. The rule contemplates the exercise (in the issue of a second patent) of authority previously exhausted (in the issue of patent earlier in order of issue).

H. The rule denies the right which the law gives to an applicant of formulating his own claim.

I. The rule denies the right which the law gives to an applicant of claiming in a patent whatsoever patentable subject-matter he *must* disclose therein.

K. The rule denies the right which the law gives for such discoveries and inventions as Bell's telephone,

Merrill's production of hydrocarbon oils, Neilson's hot blast, and this appellant's incrustation-removing means, namely, the right to one patent "as discoverer for the useful art, process, or method of doing a thing he has found, and as inventor for the means he has devised to make his discovery one of actual value."

L. The rule enjoins what the law forbids, to wit, the inclusion "in a subsequent patent" to an inventor of an "invention embraced or described in a prior patent granted to himself."

Fifth. The authority is invalid which the Commissioner exercises in refusing patents to applicants in general and a patent to the present applicant (appellant) in particular unless and until his process claims or else his claims to the new apparatus used in the performance of said process shall be canceled.

Said authority is invalid for the following reasons, severally and collectively:

(*a.*) It is invalid because unconstitutional.

(*b.*) It is without warrant of law.

(*c.*) It is unreasonable.

(*d.*) It is inconsistent with law.

As some of the many grounds upon which (*a*) unconstitutionality, (*b*) absence of legal warrant, (*c*) unreasonableness, (*d*) inconsistency with law, can and will be urged, those hereinbefore set forth in the paragraphs marked by capital letters under the first, second, third, and fourth reasons of appeal are to be taken as here set forth by way of example.

Sixth. The authority exercised in this case, of requiring applicants in general, and the present applicant in particular, to cancel a part of his claim (or any one or more of his claims) to patentable subject-matter, is invalid, especially when two patents issued—one on the part required to be canceled and the other on the remaining part—would bear to each other the following relationship severally or any two or more or all of them collectively—that is to say:

1. That of two mutually exclusive patents.

2. That of two patents with the same essential specification, neither more nor less, only the *claim* being divided between the two patents.

3. That of two patents for different reflexes or embodiment of the same conception.

4. That of two patents for the process and the apparatus respectively, which process and apparatus were both claimed in Bell's first patent in suit in Dolbear *vs.* American Bell Telephone Co., 126 U. S., 1; C. D. 1888, p. 322; 43 O. G, 377.

5. That of two. patents for the process and the apparatus respectively, which process and apparatus were both claimed in the one patent in suit in Merrill *vs.* Yeomans, 94 U. S., 568; C. D. 1877, p. 279; 11 O. G., 970.

6. That of two patents for respectively Neilson's apparatus and Neilson's method, referred to in O'Reilly *vs.* Morse, 15 How., 62.

7. That of two patents for respectively the process and the apparatus of appellant's above-entitled application.

Seventh. The authority is invalid, which was and is exercised by the Commissioner of Patents in this case, of forbidding applicants in general, and this applicant in particular, to claim all and several the new and useful matters of invention required to be disclosed by him or by them respectively in order to the obtainment of any patent whatsoever, and of refusing the application unless and until a part of his or their claim shall be canceled. This authority is invalid for the following reasons, severally and collectively:

(*a.*) It is invalid because unconstitutional.

(*b.*) It is without warrant of law.

(*c.*) It is unreasonable.

(*d.*) It is inconsistent with law.

As some of the many grounds upon which (*a*) unconstitutionality, (*b*) absence of legal warrant, (*c*) unreasonableness, (*d*) inconsistency with law, can and will be urged, those hereinbefore set forth in the paragraphs marked by capital letters under the first, second, third, and fourth reasons of appeal are to be taken as here set forth by way of example.

Eighth. The authority exercised by the Commissioner of Patents in this case of refusing or holding up applications for patents in general, and the above-entitled application in particular, upon the mere ground that the application contains both process claims and apparatus claims, is invalid, because:

(*a.*) It is unconstitutional.
(*b.*) It is without warrant of law.
(*c.*) It is unreasonable.
(*d.*) It is inconsistent with law, and upon grounds hereinbefore sufficiently set forth, the same to be taken as here repeated.

Ninth. The authority exercised by the Commissioner of Patents in this case, of refusing the above-entitled application upon any ground apparent in the record and proceedings in this case, is invalid, because:

(*a.*) It is unconstitutional.
(*b.*) It is without warrant of law.
(*c.*) It is unreasonable.
(*d.*) It is inconsistent with law, and upon grounds hereinbefore sufficiently set forth, the same to be taken as here repeated.

Tenth. The authority exercised by the Commissioner of Patents in refusing to forward appellant's appeal of December 13, 1901, to the board of examiners-in-chief, or to direct that it be forwarded, is invalid, because:

(*a.*) It is without warrant of law.
(*b.*) It is inconsistent with the statute in such case made and provided.

Some of the grounds which can and will be urged in support of these reasons are as follows:

(A.) One or more or all of the points set forth in the said appeal to the said board were proper to be considered and passed upon by the examiners-in-chief.

(B.) It is and was the duty of the said board to determine their own jurisdiction in the first instance, and not the prerogative of the examiner or of the Commissioner of Patents in person.

Eleventh. The Commissioner of Patents erred in holding that applicant (appellant) was not and is not justly entitled under the law to the patent prayed for, because the above-entitled application includes claims to a process and claims to an apparatus, or upon any ground apparent in the record and proceedings in this case.

Twelfth. The Commissioner of Patents erred in holding that because the above-entitled "application includes claims to a process and claims to an apparatus," "there-

fore the examiner properly required division." If the law authorizes (as it does authorize) one patent including claims to a process and claims to an apparatus, and if it gives (as it does give) to appellant a right to such a patent, it was the duty of the examiner and Commissioner to speed the progress of the application. If, on the other hand, the present applicant (appellant) had been found claiming (as he is not claiming) more or other than the law authorizes to be secured in the patent to be issued on the above-entitled application, it would have been the duty of the examiner to reject the applicant (or, as the statute puts it, the claim for a patent) on that ground. In any case, if he would not allow the application, it was his duty on the coming in of an appeal to the examiners-in-chief to forward the same to them for their determination of the points involved in the appeal. In no case can the Commissioner of Patents compel an applicant to file a divisional or, in fact, any application whatsoever.

Thirteenth. The Commissioner of Patents erred in holding that a "requirement for division is not an action upon the merits of the application, but is a mere matter of form." So far is it from being a mere matter of form that to secure a patent without the claims to process or to apparatus might be held by the courts to be an absolute abandonment and waiver of those claims, notwithstanding the issue of another patent containing the omitted claims.

In any event, the action is one of the merits.

(*a.*) Because the law gives inventors the right, on payment of one set of fees and the conduct of one proceeding, to secure protection for whatever matters may be authorized by law to be secured in one patent.

(*b.*) Because a patent with both process claims and apparatus claims is manifestly a different grant, as well from one whose claims are solely to process as from one whose claims are solely to apparatus.

(*c.*) Because the courts have repeatedly held claims void by reason of their having been granted in two patents instead of in one.

(*d.*) Because the legal effect of two patents is not the same as that of one patent.

(*e.*) Upon the analogy of the inclusion of two or more inventions in one patent to the inclusion of two or more patents in one bill in equity, an improper inclusion in such bill making it demurrable for multifariousness, and the decision on such demurrer being appealable, when it is against the inclusion, as a final decision on the merits of the bill.

(*f.*) Because submission to the so-called "requirement of division" involves an alteration in the specification in its very essence—that is to say, in the substance of the claim.

Fourteenth. The Commissioner of Patents erred in holding that "a party has no right of appeal to the examiners-in-chief from such a requirement" as the so-called "requirement of division." The statute gives such a party the same right of appeal which it gives to any applicant whose "claim to a patent" may be "rejected."

Fifteenth. The Commissioner of Patents erred in holding that the action in the above-entitled application "is not a refusal of a patent or patents upon the alleged invention or inventions," since obviously he did and does refuse applicant a patent covering as well the new process as the new apparatus.

Sixteenth. The Commissioner of Patents is in error as to the action on the above-entitled application being in effect "a ruling that the application has not been made in proper form," an "objection to the way in which the matter is presented, and not to the matter itself;" for in point of fact the matter in issue is neither a patent for the process divorced from the apparatus nor a patent for the apparatus divorced from the process, but a patent for the process and apparatus as one patentable discovery and invention, and no suggestion has been made of any change in the form or manner of presenting said matter which would render the present application more acceptable to the Commissioner of Patents. What he demands is that the applicant (appellant) accept a patent essentially different from that which he asks as his legal right.

Seventeenth. The Commissioner of Patents erred in rejecting above-entitled application for patent.

Eighteenth. The Commissioner of Patents erred in refusing the patent applied for.